

The opinion in support of the decision being entered today was not written for publication and is not binding precedent of the Board.

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte PALLATHERI M. SUBRAMANIAN, HOWARD CHUNG-HO NG and
ROSS A. LEE

Appeal No. 2006-1117
Application No. 10/461,308

ON BRIEF

Before KIMLIN, WALTZ, and FRANKLIN, *Administrative Patent Judges*.
WALTZ, *Administrative Patent Judge*.

DECISION ON APPEAL

This is a decision on an appeal from the primary examiner's refusal to allow claims 1 through 3, the only claims pending in this application, as amended subsequent to the final rejection (see the amendment dated Jan. 14, 2005, entered as per the Advisory Action dated April 4, 2005; Brief, page 2; Answer, page 2, ¶(4)). We have jurisdiction pursuant to 35 U.S.C. § 134.

According to appellants, the invention is directed to a multilayer film comprising at least a first resin layer of poly(1,3-propylene 2,6-naphthalate)(PPN) and a second resin layer

of poly(ethylene terephthalate)(PET)(Brief, page 2). Illustrative claim 1 is reproduced below:

1. A multilayer film comprising at least a first resin layer and a second resin layer wherein the first resin layer comprises poly (1,3-propylene 2,6-naphthalate) and the second resin layer comprises poly (ethylene terephthalate).

The examiner has relied upon the following references as evidence of unpatentability:

Rayburn	5,055,965	Oct. 08, 1991
Marotta et al. (Marotta)	5,888,640	Mar. 30, 1999

Claim 1 stands rejected under 35 U.S.C. § 102(b) as anticipated by Rayburn (Answer, page 3). Claims 2 and 3 stand rejected under 35 U.S.C. § 103(a) as unpatentable over Rayburn in view of Marotta (*id.*).

We *affirm* both rejections on appeal essentially for the reasons stated in the Answer, as well as those reasons set forth below.

OPINION

A. The Rejection under § 102(b)

The examiner finds that Rayburn discloses a multilayer film comprising at least a first resin layer and a second resin layer, where the first resin layer comprises PPN and the second resin layer comprises PET (Answer, page 3). Therefore the examiner finds

that Rayburn describes every limitation of claim 1 on appeal within the meaning of § 102(b)(Answer, pages 3 and 5). We agree.

Appellants argue that the Rayburn "web" is not a "layer" as used in the present invention and disagree with the examiner's characterization that the films of Rayburn are laminated to form a multilayer film (Brief, page 3).

It is implicit in our review of the examiner's anticipation analysis that the claim first must have been correctly construed to define the meaning and scope of any contested limitations. See *Gechter v. Davidson*, 116 F.3d 1454, 1457, 43 USPQ2d 1030, 1032 (Fed. Cir. 1997). During prosecution before the examiner, we give the claim language its broadest reasonable meaning in its ordinary usage at it would have been understood by one of ordinary skill in the art, taking into account any definitions or guidelines set forth in the specification. See *In re Morris*, 127 F.3d 1048, 1054, 44 USPQ2d 1023, 1027 (Fed. Cir. 1997).

Claim 1 on appeal recites a "multilayer film," which in its ordinary usage simply means a film structure having two or more layers, which is clearly the intended meaning since the body of claim 1 requires "at least a first resin layer and a second resin layer." Claim 1 on appeal also uses the transitional term "comprising" which means that the claim is open to include other

films, layers or elements. See *Genentech Inc. v. Chiron Corp.*, 112 F.3d 495, 501, 42 USPQ2d 1608, 1613 (Fed. Cir. 1997) ("`Comprising' is a term of art used in claim language which means that the named elements are essential, but other elements may be added and still form a construct within the scope of the claims."). The second portion of the body of claim 1 requires that at least a part of the first resin layer is PPN (the first resin layer "comprises") and at least a part of the second resin layer is PET (the second resin layer "comprises"). Giving the claim language its broadest reasonable meaning in light of the specification as it would have been understood by one of ordinary skill in the art, without reading limitations into the claims from the specification, we find no requirement that the first and second resin layers are adjacent or touching each other. See the specification, page 3, ll. 29-32, where it is taught that "[o]ne or more additional resin layers" can be present in the multilayer film structure. See also page 9, ll. 22-36, of the specification where it is taught that the "multilayer films of the current invention" can include more than one layer of PPN (i.e., 3GN) and/or PET, in addition to "additional layers of other polymers" that are compatible with PPN and PET. We also note that the specification discloses that the "multilayer oriented films or containers of the invention can be coated with a metal"

(specification, page 12, ll. 25-27). Contrary to appellants' argument (Brief, page 5), we find no express disclaimer that every "layer" must be a different polymer (specification, page 9, ll. 22-36). See *In re Bigio*, 381 F.3d 1320, 1325, 72 USPQ2d 1209, 1210-11 (Fed. Cir. 2004) (The PTO should only limit the claim based on an express disclaimer of a broader definition).

In view of the above discussion, we construe claim 1 on appeal as including a film structure of at least two layers, possibly including any other layers or elements, with at least one layer designated as the "first resin layer" including at least a portion of PPN and at least another layer designated as the "second resin layer" including at least a portion of PET, where the first and second resin layers may be in any position or order in the structure.

Therefore we determine that appellants' arguments are not well taken. Appellants, contrary to their own argument, admit that Rayburn describes that the web comprises a film and has two layers (Brief, page 3), although we note that this "web" includes both a metallized layer and an opposite dielectric layer (see Rayburn, col. 2, ll. 8-10, and Figure 3). Rayburn also clearly discloses structures including multiple webs (see Figures 2 and 3 as well as

col. 2, ll. 29-31). Accordingly, we determine that Rayburn clearly describes multilayer film structures.

Appellants argue that Rayburn describes the web as a single layer film comprising preferably PET or alternatively PPS or PEN, noting that the language "such film" or "alternately" is singular and there is no teaching in Rayburn of making the webs of different polymers (Brief, pages 3-4, citing Yoshii et al., U.S. Patent No. 4,756,064, for the method of making the webs of Rayburn; Reply Brief, pages 2-3). Appellants further argue that the Rayburn disclosure of the use of "similar" films in different webs "can denote only that the two webs are comprised of the same polymer" (Brief, page 6, emphasis omitted; Reply Brief, page 3).

Appellants' arguments are not persuasive. As correctly found by the examiner, Rayburn clearly disclose at least two webs in a multilayer film structure (Answer, page 5; see col. 6, ll. 41-49, and Figure 3). As also correctly found by the examiner, for each laminate, Rayburn discloses that the laminate is comprised of two relatively thick webs of metallized dielectric film "such as PET, PPS, or PPN" since these thick films tend to be self-supporting (col. 2, ll. 28-36; see the Answer, page 3).¹ We determine that a

¹Appellants do not argue or dispute the examiner's finding that "PPN" as disclosed by Rayburn is an abbreviation for poly(1,3-propylene 2,6-naphthalate)(Answer, page 3)(see the Brief

genus of only three materials constitutes a description of the specific PPN layer, including the use of PET as another dielectric layer in the web of the film structure. *See In re Schaumann*, 572 F.2d 312, 316, 197 USPQ 5, 9 (CCPA 1978); *In re Sivaranakrishnan*, 673 F.2d 1383, 1384, 213 USPQ 441, 442 (CCPA 1982). We determine that the disclosure of Rayburn does not limit the selection of dielectric material to only one resin but the choice of the three resin materials is available for *each* dielectric film in the multiple webs. Furthermore, Rayburn discloses that, for multiple webs, the dielectric film of the second web should be "similar" to the dielectric film of the first web (col. 6, ll. 41-49). Contrary to appellants' unsupported argument (Brief, page 6; Reply Brief, page 3), we find no basis that "similar" means the "same." As correctly argued by the examiner (Answer, page 8),² we find that the structures of PET (an aromatic dicarboxylic acid ester) and PPN (an aromatic dicarboxylic acid ester) would have been considered

and Reply Brief in their entirety).

²We do not agree with the examiner's position concerning the Rayburn embodiment where carrier tape is employed (Answer, paragraph bridging pages 8-9) since PPN is not disclosed by Rayburn except for embodiments where the carrier tape is omitted (e.g., compare col. 2, ll. 28-31 with col. 2, ll. 8-12). However, this alternative embodiment is not essential to the rejection as discussed above.

"similar" materials within the description of Rayburn, especially with respect to the PPS material.

For the foregoing reasons and those stated in the Answer, we determine that the examiner has established a *prima facie* case of anticipation in view of Rayburn, which has not been adequately rebutted by appellants' arguments. Therefore we affirm the examiner's rejection of claim 1 on appeal under 35 U.S.C. § 102(b) over Rayburn.

B. The Rejection under § 103(a)

Appellants' only argument concerning this rejection is that "Marotta et al. does not cure the deficiencies of Rayburn, as set forth above" (Brief, page 7). Therefore we adopt our comments concerning Rayburn as discussed above, as well as adopt the examiner's findings of fact and conclusion of law regarding this rejection (Answer, pages 3-4).

The rejection of claims 2-3 under 35 U.S.C. § 103(a) over Rayburn in view of Marotta is thus affirmed.

Accordingly, the decision of the examiner is affirmed.

C. Time Period for Response

No time period for taking any subsequent action in connection with this appeal may be extended under 37 CFR § 1.136(a)(1)(iv)(2004).

AFFIRMED

EDWARD C. KIMLIN)	
Administrative Patent Judge)	
)	
)	
)	
)	BOARD OF PATENT
THOMAS A. WALTZ)	APPEALS
Administrative Patent Judge)	AND
)	INTERFERENCES
)	
)	
)	
BEVERLY A. FRANKLIN)	
Administrative Patent Judge)	

TAW/sld

Appeal No. 2006-1117
Application No. 10/461,308

Page 10

E I DU PONT DE NEMOURS AND COMPANY
LEGAL PATENT RECORDS CENTER
BARLEY MILL PLAZA 25/1128
4417 LANCASTER PIKE
WILMINGTON, DE 19805